

MEMORANDUM**DATE:** May 3, 2001**TO:** Patent Examining Corps Directors**FROM:** Esther M. Kepplinger

Deputy Commissioner for Patent Operations

SUBJECT: Procedures for Treatment of Drawings in Utility Applications

Summary: The Office of Initial Patent Examination (OIPE) will be reviewing drawings in new utility and plant applications filed on or after November 29, 2000 and will not release applications to the Technology Centers unless acceptable drawings are present. ~~Drawings filed after the application has been released by OIPE are no longer required to be reviewed by the draftsman. The drawings will be accepted as publishable unless the Examiner is not able to use the new drawings in the examination of the application.~~ (See Manual of Patent Examining Procedure (MPEP), Sections 608.02(d)-(g).) A draftsman's "stamp" indicating approval is not required on patent drawings. **Examiners should not require new drawings just because the drawings have been indicated by applicant to be "informal." Applicants are required to submit drawing corrections promptly, and corrections should no longer be held in abeyance until the application has been allowed. After the application has been allowed, extensions of time are not available to the applicant for filing corrected drawings.**

This memo does NOT set forth the procedure for processing design or plant drawings.

I. OIPE Review of Drawings

Drawings in utility and plant applications filed on or after November 29, 2000, other than continued prosecution applications (CPAs), will be reviewed in the OIPE for compliance with certain requirements of 37 CFR 1.84. OIPE will send applicant a Notice to File Corrected Application Papers if the drawings are not acceptable. See the attached NOTICE TO FILE CORRECTED APPLICATION PAPERS for examples of typical drawing defects that will be identified by OIPE. OIPE will not release applications to the Technology Centers until acceptable drawings are filed.

Drawings filed in design patent applications (whether filed before or after November 29, 2000) are not reviewed by OIPE.

II. Draftsman's Review of Drawings

A draftsman will ordinarily not be required to review the drawings in a utility or plant application. A draftsman's "stamp" to indicate approval is no longer required on patent drawings, and these stamps are no longer to be used by draftsmen. The examiner need only have the Draftsman review the drawings if the examiner would like the draftsman's assistance in identifying errors in drawings. If a draftsman reviews drawings, and finds the drawings to be unacceptable, the draftsman should complete a PTO-948 for the examiner to include with the next Office action.

III. Instructions for Examiners Regarding Drawings

A. On First Action (Non-allowance):

If there is a PTO-948 in the patent application file wrapper, the PTO-948 should be mailed with the examiner's first written communication to the applicant (e.g., restriction requirement or first Office action on the merits). In addition, the examiner should consider whether the drawings are complete, modifications are appropriately shown, and whether drawings which show prior art are necessary and properly labeled. (See MPEP, Sections 608.02(d)-(g).) Any deficiency the examiner notes in the drawings, other than those listed on the PTO-948, should be noted by the examiner in an Office action (other than a restriction requirement) via the *Office Action Summary form PTO-326* and appropriate form paragraphs.

Regardless of whether the objection is indicated on a PTO-948 or in an Office action, correction (or a proposed correction (see 37 CFR 1.121(d))) is required in reply to the Office action and examiners may not permit corrections to be held in abeyance. If drawing requirements have been held in abeyance, the next Office action should require correction and state that corrections may no longer be held in abeyance.

B. On Subsequent Actions:

The examiner should determine whether a prior Office action required a drawing correction, and whether applicant has submitted drawings or a reply to a prior requirement.

(1) If applicant voluntarily submits drawings without a requirement for a correction having been made, the examiner should acknowledge receipt of the drawings stating whether the drawings are substantively acceptable to the examiner. (See MPEP Sections 608.02(d)-(g).) If the drawings are not acceptable, the examiner should provide an explanation (which may include reference to an attached PTO-948).

(2) If the prior Office action required drawing corrections and the applicant submits one of the following:

a. Proposed drawing corrections-

The examiner should review the proposed drawing corrections and determine if the proposed changes (shown in red ink as required by 37 CFR 1.121(d)) are acceptable and satisfy any earlier requirements noted by the examiner. If the changes are acceptable, the examiner should write "*approved*," the examiner's initials, and the date on the cover letter for the proposed drawing corrections or the first page of the proposed drawing correction. The applicant should be notified via the *Office Action Summary form PTO-326* that the proposed drawing corrections have been approved and corrected drawings are required in reply to the Office action. If the proposed drawing corrections are not acceptable, the examiner should write "*disapproved*," the examiner's initials, and the date on the cover letter for the proposed drawing corrections or the first page of the proposed drawing correction. The examiner should also explain the reason for the disapproval using form paragraph 6.38 in the next Office action. Correction must be required in reply to the Office action.

b. Corrected acceptable drawings-

The examiner should acknowledge receipt of the drawings in the next Office action using form paragraph 6.37.

c. Replacement drawings that are Unacceptable-

The examiner should acknowledge receipt of the drawings using form paragraph 6.37, explaining why the corrected drawings are unacceptable to the examiner. Form paragraph 6.24 should no longer be used. Correction must be required in reply to the Office action.

d. Argument that the drawing requirement was improper-

The examiner should consider the arguments made, and reply with either an explanation of why the arguments are not persuasive and the drawing requirement is appropriate, or a statement that the arguments were persuasive and the drawing correction is no longer necessary.

e. Request for drawing requirement to be held in abeyance with neither drawings nor proposed drawing corrections -

If the examiner's requirement was made before the date of this memo, the examiner may have permitted the drawing correction to be held in abeyance until the application was allowed (old form paragraph 6.24)). If this has occurred, the examiner should repeat the requirement, stating that correction must be made in reply to the Office action. See 37 CFR 1.85(a).

Otherwise, the examiner should hold the reply non-responsive, using form paragraph 7.91.

C. On Allowance:

As explained in (B) above, the examiner should treat all proposed drawing corrections and new drawings, and indicate the status (acceptable/not acceptable) of the proposed drawing correction or new drawings, if the status has not been indicated previously. If drawings have been added or amended, the examiner should check the brief description of the drawings to ensure that there is a brief description of each drawing and that every drawing that is described in the specification is included in the file and accepted. It is acceptable for the brief description of figures 1A, 1B and 1C to read "Figure 1 shows a telephone system." Figures 1A, 1B and 1C are not each required to have a brief description. If figure 1A is briefly described but figures 1B and 1C are not, the brief description should be amended to add the description of these figures. Except in the situation noted, the examiner should not allow an application if a figure is included and there is no brief description of the figure. Additionally, the examiner should not allow an application if there is a brief description of a figure but the figure is not in the application, except in this situation.

Examiners should not require "formal" drawings merely because the applicant indicated that the drawings submitted on filing were informal. The box for such a requirement on the Notice of Allowability has been eliminated. As explained above, applicants must be informed of the objections to the drawings either with a PTO-948 or the relevant form paragraphs. If drawing corrections are required at allowance, the examiner should mark the appropriate box on the Notice of Allowability (Form PTO-37), referencing either a PTO-948, an attached explanation, or a proposed drawing correction.

Extensions of time to provide acceptable drawings after the issue fee has been paid are no longer permitted. The Notice of Allowability has also been changed to eliminate

applicant's ability to obtain an extension of time to file corrected drawings. See 37 CFR 1.85(c).

A "Yellow Tag" is no longer required, and may be removed from any patent application.

If the Office of Publications receives drawings that cannot be scanned or are otherwise unacceptable for publication, the Office of Publications will mail a requirement for corrected drawings, giving applicant a shortened statutory period of TWO MONTHS (with no extensions permitted) to reply. The drawings will ordinarily NOT be returned to the examiner for corrections.

Attachment: NOTICE TO FILE CORRECTED APPLICATION PAPERS (sample)